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IN THE UNITED STATES OF AMERICA
PATENT AND TRADEMARK OFFICE

APPLICANT: Kenneth W. Kolb

EXAMINER: Josiah C. Cocks

SERIAL NO.: 10/003,877

ART UNIT: 3473

FILING DATE: October 25, 2001

ATTY. DOCKET: 16313/94484-00

TITLE: Insertable Thermotic Module for Self-Heating Can

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action of December 30, 2003, please consider the following reasons requesting withdrawal of the rejections of record.

REMARKS

In the 12/30/03 Office Action, the Examiner maintained his rejection of all claims on largely the same grounds as stated in the earlier 04/24/03 Office Action. In particular, the Examiner maintained his rejection of claim 1 based upon the allegedly "inherent" disclosure of U.S. Patent No. 4,793,323 to Guida, et al ("Guida"). Applicant respectfully submits that the Examiner's inherency argument is clearly incorrect for the following reasons.

The Examiner's rejection of claim 1 is plainly contrary to MPEP §2112 which explains an examiner's burden of proof when making an inherency rejection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency,

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however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " (citations omitted)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis in original)

In response to applicant's 10/22/03 arguments that Guida did not inherently disclose the limitations of claim 1, the Examiner stated:

Applicant argues that, although the cup of Guida et al. is made of a material noted by applicant (see spec. pp. 12-13) and specifies one embodiment of a wall thickness that is within a range noted by applicant (see spec. p. 13), the cup would likely not have a sufficiently low Vicat Softening Point. Applicant simply asserts that 0.5 mm polyethylene would likely not have the proper Vicat Softening Point and argues that Guida et al. would not want any plastic expansion. This assertion is not supported by the prior art of record. The examiner considers that the walls of Guida et al. would have a sufficiently low Vicat Softening Point to allow some expansion of the cup when heated. The rejection of claim 1 based on the statement of inherency is, therefore, maintained.

First, the Examiner has not explained why or how applicant's assertion that 0.5 mm polypropylene would not have a sufficiently low Vicat Softening Point "is not supported by the prior art of record." The Examiner has pointed to nothing in the prior art which suggests that 0.5 mm polypropylene would have a sufficiently low Vicat Softening Point. Moreover, as clearly explained in applicant's 10/22/03 Response, applicant's specification does not indicate that 0.5 mm polypropylene has a sufficiently low Vicat Softening Point. Applicant's specification only states that wall thickness may vary between 0.001 mm and 0.65 mm depending on the type of plastic used. This is *not* stating that applicant uses 0.5 mm polypropylene or that 0.5 mm polypropylene is equivalent to what is claimed. Applicant respectfully submits that the Examiner's assertion to the contrary is not a reasonable interpretation of applicant's specification.

Second, as MPEP §2112 makes clear, inherency is not established even if it is *probable* that the missing characteristic may be present in the prior art. Rather the examiner must show

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that the missing characteristic is *necessarily* present in the prior art. Again, applicant respectfully submits that the Examiner has not shown why 0.5 mm polyethylene would *necessarily* have a sufficiently low Vicat Softening Point.

As further evidence that it is unlikely that polypropylene has a sufficiently low Vicat Softening Point (particularly in the 60 °C to 120 °C range recited in claim 2), applicant references a polypropylene table of properties attached as Exhibit 1. Exhibit 1 is taken from *Know Your Plastics*, by Stacpoole Communications Pty Ltd and published by the Plastics Industry Association Incorporated of Melbourne, Australia, 1992, 2nd Ed. Although applicant cannot be certain that all types of polypropylene or all test methods give the Vicat Softening Point of 148 °C shown in Exhibit 1, applicant submits that this is far better evidence than anything the Examiner has cited. Further, this evidence is clearly contrary to the Examiner's unsupported assumption that Guida's polypropylene would have the Vicat Softening Point claimed by applicant. Given the evidence of record, no reasonable fact finder could conclude that Guida or any other prior art of record teaches that polypropylene would inherently have the Vicat Softening Point parameters claimed by applicant.

On page 3 of the 12/30/03 Office Action, the Examiner also repeated his earlier rejection of claims 2, 3, and 6-15 stating that the claimed attributes "are described as the equivalent of the polypropylene and wall thickness disclosed by Guida et al." As applicant pointed out in his 10/22/03 Response, applicant's specification does not describe these claim limitations as the equivalent of the 0.5 mm polyethylene disclosed in Guida. As an example, claims 2 and 3 recite limited ranges of Vicat Softening Points. Nothing in applicant's specification states that 0.5 mm polyethylene has or is likely to have the Vicat Softening Points recited in claims 2 and 3. The Examiner's rejection vaguely mentions page 13 of applicant's specification, but never points out

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the language that shows the alleged equivalence. This is despite the fact that applicant's 10/22/03 response explained in detail why pages 12 and 13 do not teach what the Examiner alleges. The same objection can be made of the Examiner's rejection of claims 6-15. Applicant respectfully submits the Examiner's conclusory statements which are unsupported by the facts of record are not a sufficient basis for a proper rejection.

Applicant believes that careful reconsideration of the inherency rejections in view of MPEP §2112 will lead the Examiner to withdraw these rejections, particularly in reference to claims 2 and 3.

Respectfully Submitted:

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CERTIFICATE OF FACSIMILE

I hereby certify that this document is being facsimile transmitted to the Commissioner of Patents and Trademarks, (703) 872-9306, on the date shown below.


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TABLE 2
PROPERTIES OF COMMERCIAL POLYPROPYLENES

PROPERTY	TEST METHOD	HOMOPOLYMER			BLOCK COPOLYMER	
Melt Flow	2.16kg, 230°C	3.0	0.7	0.2	3.0	0.2
Tensile Yield Strength (MPa)	50mm/min	34	30	29	29	25
Flexural Modulus (MPa)	ASTM D790	1310	1170	1100	1290	1030
Vicat Softening Point (°C)	BS 2782	148	148	148	148	147
Rockwell Hardness	R Scale	95	90	90	95	89
Impact Strength (J)	Falling Dart. 20°C	13	34	46	46	58

Random copolymers are particularly useful for clear blow moulded containers. Typical properties at the same MFI are shown in Table 3 for the different types of polypropylene.

TABLE 3 - PROPERTIES OF RANDOM COPOLYMERS, HOMOPOLYMERS AND BLOCK COPOLYMERS
- TYPICAL VALUES

PROPERTY	RANDOM COPOLYMER	HOMOPOLYMER	BLOCK COPOLYMER
Melt Index, g/10 min	1.5	1.5	1.5
Izod Impact at 0°C, kJ/m.	7	2	11
Tensile Yield Strength, MPa	24	33	28
Flexural Modulus, MPa	900	1600	1100

EXHIBIT

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